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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,622	03/29/2006	Tomi Jarvinen	06267.0126	8385
22852	7590	09/14/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER STOCKTON, LAURA LYNNE	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 09/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,622

Applicant(s)

JARVINEN ET AL.

Examiner

Laura L. Stockton, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/29/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1626

DETAILED ACTION

Claims 1-10 are pending in the application.

Rejections made in the previous Office Action that do not appear below have been overcome by Applicant's amendments to the claims. Therefore, arguments pertaining to these rejections will not be addressed.

Information Disclosure Statement

The Examiner has considered the Information Disclosure Statement filed on June 29, 2007.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the

Art Unit: 1626

differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aono et al. {JP 10-195056} and Karjalainen et al. {WO 97/12874}, each taken alone, or Karjalainen et al. in view Huhtala et al. {WO 01/051472}. A machine translation of the JP document has been provided and will be referred to hereinafter.

*Determination of the scope and content of the prior art (MPEP
§2141.01)*

Applicant claims imidazole compounds. Aono et al. (see entire document; particularly paragraphs [0004], [0005], [0009], [0024] and [0027]-[0029]; and especially Example 1 on page 51 and Example 30 on page 53) and Karjalainen et al. (see entire document; particularly pages 1-4, 11 and 12; and especially Example 15 on page 30) each teach imidazole compounds that are structurally similar to the instant claimed compounds.

Art Unit: 1626

Ascertainment of the difference between the prior art and the claims

(MPEP §2141.02)

The difference between the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art. Further, Huhtala et al. (page 8, last full paragraph) teach the interchangeability of esters of aliphatic and aromatic alcohols.

Finding of prima facie obviousness--rational and motivation (MPEP

§2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., treating glaucoma).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of

Art Unit: 1626

obtaining additional beneficial products which would be useful in treating, for example, various cancers, glaucoma, etc. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Response to Arguments

Applicant's arguments filed June 29, 2007 have been fully considered but they are not persuasive.

Applicant argues that: (1) the disclosure of Aono et al. is broad; (2) Aono et al. teach away from the instant claimed compounds since none of the specific compounds disclosed in Aono et al. possess the substitution pattern of the present compounds; and (3) Aono et al. is silent to the treatment of the diseases and or conditions instantly claimed.

All of Applicant's arguments have been considered but have not been found persuasive. Applicant claims

Art Unit: 1626

imidazole compounds. Aono et al. teach imidazole compounds that are structurally similar to the instant claimed compounds. Although one may consider the disclosure in Aono et al. broad, the teaching in Aono et al. would direct one skilled in the art toward in the instant claimed compounds. Applicant argues that Aono et al. teach away from the instant claimed compounds since none of the specific compounds disclosed in Aono et al. possess the substitution pattern of the present compounds. In response, it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In re Boe, 148 USPQ 507, 510 (CCPA).

Applicant argues that Aono et al. is silent to the treatment of the diseases and or conditions instantly claimed. In response, there is no requirement that the

Art Unit: 1626

prior art must suggest that the claimed product will have the same or similar utility as that discovered by applicant in order to support a legal conclusion of obviousness. In re Dillon, 16 U.S.P.Q. 2d 1897, 1904 (Fed. Cir. 1990). The rejection is deemed proper and therefore, the rejection is maintained.

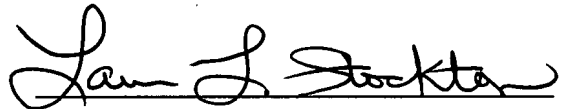
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the

Art Unit: 1626

automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in cursive script, reading "Laura L. Stockton".

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

September 6, 2007